

REMARKS

The last Office Action has been carefully considered.

It is noted that claims 9, 13, 14, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art of Figure 1 in view of U.S. patent to Schmitt and Japanese patent to Kihara.

Also, the claims are rejected under 35 U.S.C. 112.

In connection with the Examiner's rejection of the claims for formal reasons under 35 U.S.C. 112, applicants have amended claim 9, the broadest claim on file, to eliminate the grounds for the formal rejection.

It is believed that the formal rejection applied by the Examiner should be considered as no longer tenable and should be withdrawn.

After carefully considering the Examiner's grounds for the rejection of the claims over the art, applicant submits that the present invention as defined in the current claims clearly and patentably distinguish from the prior art.

Turning now to the references, it is respectfully submitted that in the Examiner's opinion the APA discloses three adjusting screws mounted by plastic insert in the base plate with two of them located in diagonally opposed corners and guided by screw threads in the insert, wherein APA does not disclose the adjusting screws including a deflecting linkage. It is correct that the APA does not disclose any adjusting screws including a deflecting linkage, and also the APA does not disclose three screws, as can be seen from Figure 1, wherein only two screws are shown. The Examiner further indicated that the patent to Schmitt teaches a mount with an adjusting screw and a reflecting linkage operative for producing a deflection of a rotary motion of the spindle at approximately a right angle; however, it does not teach a mount in which the reflecting linkage produces a reflection of a rotary motion of the rotary spindle approximately at a right angle, to provide the rotation of the rotary spindle approximately perpendicular to an emission direction.

The Examiner further indicated that it would have been obvious to have modified the mount of the APA by substituting the adjusting screw arrangement disclosed by Schmitt for adjusting the screws, because of alleged motivation to permit a user to control the movement and adjustment of the device from a more conveniently accessible position as taught by

Schmitt.

Applicants have to respectfully disagree with this opinion. the references do not contain any hint or suggestion, motivation for combining them in any way, for taking from them and combining any of their features, for doing anything remotely resembling what the applicants did.

In connection with this, the Examiner's attention is respectfully directed to the decision in re Fritch, 23 USPQ 2d 1780, 1783-84 (Fed. Cir. 1992) in which it was stated:

"The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

Definitely, none of the references suggest any modifications, and therefore the modification of one reference by the teaching of the other reference as applied can not be considered as obvious.

As for the Examiner's statement that it is obvious to provide the combination to control the movement and adjustment of the device from a more conveniently accessible position, the Examiner's attention is respectfully directed to the decision Fromson v. Anitec Printing Plates, Inc., as reported in 45 USPQ 2d 1269, 1276 (Fed. Cir. 1997):

"That an inventor is probed the strength and weakness of the prior art and discovered an improvement that escapes those who came before is indicative of unobviousness, not obviousness. The district court did not correctly apply the law obviousness, for there is no suggestion or teaching in the prior art to select from the various known procedures and combine specific steps, along with a new electrical structure in the way that is described and claimed by Fromson. The judgment of invalidity is reversed."

Also, it is believed to be advisable to cite the decision *W. L. Gore & Assocs, Inc. v. Garlock, Inc.* as reported in 220 USPQ 303, 312-13 (Fed. Cir. 1983) as follows:

"To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teaching."

It is therefore believed that the Examiner's opinion that the present invention as defined in claim 9 can be derived from the combination of the APA in the patent to Schmitt should be considered as not applicable and should be withdrawn.

The Examiner further stated that in view of the patent to Kihara, it would have been obvious to have modified the mount to include a spring engaged with the bevel gear because it would have been obvious to provide means for energizing or biasing the bevel gear in the engaging direction of the other bevel gear as taught by Kihara. It is believed that the above presented decisions should be considered as completely applicable to the

combination of the above-discussed patents with the patent to Kihara as well. While the patent to Kihara suggests the use of a spring, it is not obvious to combine the teaching of this reference with the teachings of the previous two references in order to arrive at the applicant's invention.

Also, the present invention provides for the highly advantageous results which are not and can not be accomplished by the constructions disclosed in the references. It is known that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such a modification.

This principle has also been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision in re Randol and Redford (165 USPQ 586) that

Prior patents are references only for what they clearly disclose or suggestion; it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.


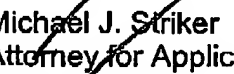
In view of the above presented remarks and amendments, it is believed that claim 9, the broadest claim on file, should be considered as patentably distinguishing over the art and should be allowed.

It is also respectfully submitted that the dependent claims, in combination of the features of the dependent claim 9, also contain a patentable subject matter, and therefore they should be allowed.

Reconsideration and allowance of the present application is most respectfully submitted.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,



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